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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,963	02/23/2004	Denny Chiu	16813-SUS	7567
20/988 7590 12/15/2009 OGILVY RENAULT LLP 1, Place Ville Marie SUITE 2500 MONTREAL, QC H3B 1R1 CANADA				
EXAMINER				
KARIKARI, KWASI				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/782,963

Applicant(s)

CHIU ET AL.

Examiner

KWASI KARIKARI

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-12 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-12 and 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 09/23/2009 have been fully considered but they are not persuasive.

a. In the remarks, the Applicant argues that the combination of Martinez, Parker and Moton is not proper and also fails to disclose the claimed limitations; [“...at least two different event generating and handling components on the mobile device are provided, wherein the event generating and handling components on the mobile device include at least two of an alarm, a calendar, email, phone and SMS”], (see claims 1, 10 and 20).

The Examiner, however respectfully disagrees with such an assertion.

In contrast to Applicant's assertion, **Martinez** is understood to teach a cellular telephone that a user could operate to select preference information correspond to ringing or vibration of the telephone when the user receives incoming call (see [0004-5]). Martinez also mentions electronic an agenda/calendared agenda as specified condition with respect to the operation of the telephone (see [0008, 0022 and 26]).

Martinez explicitly fails to teach “wherein the event generating and handling components on the mobile device include an alarm, a calendar, **email and SMS**”.

However, **Parker**, which is an analogous art, equivalently teaches a computing device that has the capability to use audible, flashing light and vibration to notify users of appointments, reception of email, incoming calls and text (see [0002-3, 0005, 0036] and TABLE 1).

In addition to **Martinez and Parker**, **Moton**'s reference is also understood to mention a server 102 that uses location information from location systems 106 and 112; and identity information to activate service features subscribed by a subscriber (see col. 5, line 4- col. 6, line 19; col. 9, lines 39-66 and table 1).

Therefore, the Examiner maintains that the combination of Martinez, Parker and Moton, as shown above, meets the Applicant's argued claimed limitations.

b. With regard to the Applicant's argument relating to an improper combination of Martinez, Parker and Moton, the Examiner respectfully disagrees with such an assertion because obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Martinez, Parker and Moton, which are analogous arts, teaches wireless notification and control systems. It would have been obvious at the time the invention was made to have combined both references to achieve a communication system that automatically controls specific notifications based on user profile and trigger/events.

c. All the dependent claims are also being rejected by virtue of their dependency on their respective dependent claims.

Based on the above response/clarifications the Office Action is being maintained and made Final as shown below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3-12 and 14-20 are rejected under U.S.C. 103(a) as being unpatentable over Martinez (U.S. 20020142792 A1), (hereinafter Martinez) in view of Parker et al., (US 20020116541 A1), (hereinafter, Parker) and further in view of Moton, Jr. et al., (U.S. 7,116,977), (hereinafter Moton).

Regarding claims 1,10 and 20, Martinez discloses a method/mobile device/computer program product/ for enabling a mobile device (= device 10, see Figs. 1 and 6-8) to control notification of events , the method comprising:

activating, at the mobile device, a first notification profile (= user preference

settings/information or operational set, see Pars. 0021-24 and 0026) comprising a first set of notification control options selected at the mobile device (see Pars. 022-25) wherein the mobile device is capable of comparing both a time parameter and a location parameter with a current time and a current location (= time of day and network present, see Pars. 0022-25);

enabling definition of any enabled switch condition (=trigger, see Par. 0021-22) by directly specifying at least one of the time parameter and the location parameter at the mobile device (see Pars. 0021-22); and

switching to a second notification profile (= user preference settings/information or operational set, see Pars. 0021-24 and 0026) when the switch condition (= trigger) defined at the mobile device is satisfied (see Pars. 0021-25), the second notification profile comprising a second set of notification control options (see Pars. 0021-25);

wherein the first and second notification profiles (= user preference settings/information or operational set, see Pars. 0021-24 and 0026) each define respective notification control options (see Pars. 0021 and 0026) that apply to the notification of events, each event being generated by a respective event generating and handling component, the first and second notification profiles each defining notification control options controlling how notifications for events generated by different event generating and handling components on the mobile device are provided, wherein the event generating and handling components on the mobile device include phone (see Pars. 0021-23, 0024-25, 0030, 0032, 0037-41 and Figs. 6-8). **Martinez** also mentions electronic agenda/calendared agenda as specified condition (see [0022 and 26]).

Martinez explicitly fails to teach "wherein the event generating and handling components on the mobile device include an alarm, a calendar, email and SMS" and that the current location is determined using at least one of a cellular base station or a Global Positioning System (GPS).

However, **Parker**, which is an analogous art, equivalently teaches "wherein the event generating and handling components on the mobile device include an alarm, a calendar, email and SMS (= audible email notification; and calendar-type application program may generate the selected signal see [0002, 0010, 0020, 0051-53, 0055 and 0057]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Parker with the system of Martinez for the benefit of achieving a notification system that each profile may be configured to provide different types of notifications for a plurality of different types of notification-type events (see Parker, [0020]).

The combination of **Martinez and Parker** explicitly fails to disclose that the current location is determined using at least one of a cellular base station or a Global Positioning System (GPS).

However, the proceeding limitations are disclose in the system of **Morton** wherein the server 102 uses location information from location systems 106 and 112; and identity information to activate service features subscribed by a subscriber (see col. 5, line 4- col. 6, line 19; col. 9, lines 39-66 and table 1).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Moton with the system of Martinez and Parker for the benefit of achieving a system that includes GPS and GIS systems to provide redundancy, accuracy and reliability (see Moton, col. 5, lines 4-19).

Regarding claim 3, Martinez further discloses the method of claim 1 wherein said switch condition is defined in relationship with both the time and location parameters (= condition/trigger which can be sensed include type of day and the location of the cellular telephone, see Pars. [0009 and 0022]).

Regarding claims 4, as recited in claim 1, the combination of Martinez and Parker fails specifically to mention that said current location is determined only using Global Positioning System.

However, **Morton** teaches that the system includes one or both network-based location systems 106 and 112 (see col. 5, lines 4-19 and col. 4, line 58- col. 5, line 61).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Moton with the system of Martinez and Parker for the benefit of achieving a system that includes GPS and GIS systems to provide redundancy, accuracy and reliability (see Moton, col. 5, lines 4-19).

Regarding claim 5, Martinez further discloses the method of claim 1 wherein said method comprising storing the switch condition in association with one of the first and

second notification profiles to facilitate re-use of a stored switch condition (see Pars. 0005, 0008, and 0021).

Regarding claim 6, Martinez further discloses the method of claim 5, wherein defining the switch condition comprises accessing the stored switch condition for re-use (see Pars. 0005, 0008, and 0021-23).

Regarding claim 7, Martinez further discloses the method of claim 1, wherein said first notification profile comprises options defined to disable notification of at least some of the events and said second user notification profile comprises options defined to enable notification of said at least some of the events whereby the switching automatically enables notification upon the satisfaction of the switch condition (see Pars. 0021-26).

Regarding claim 8, Martinez further discloses the method of claim 1, wherein said first notification profile comprises options defined to enable notification of at least some of the events and said second notification profile comprises options defined to disable notification of said at least some of the events whereby the switching automatically disables notification upon the satisfaction of the switch condition (see Pars. 0021-26).

Regarding claim 9, Martinez further discloses the method of claim 1, comprising: enabling said first notification profile to control the notification thereby replacing a previously enabled notification profile; and defining said second notification profile in

accordance with said previously enabled notification profile such that said switching automatically re-enables the previously enabled notification profile (see Pars. 0021-26).

Regarding claim 11, Martinez further discloses the device of claim 10, comprising: wherein the notification profile enablement component enables definition, at the mobile device, of switch conditions for more than one of said notification profiles (see Pars. 0009 and 0021-26).

Regarding claim 12, Martinez further discloses the device of claim 11 wherein the notification profile enablement component defines switch conditions in response to both the time parameter and the device location parameter (see Pars. 0009 and 0021-26).

Regarding claim 14, Martinez further discloses the device of claim 10 comprising a switch condition monitoring component to monitor the satisfaction of the switch condition to determine the automatic switching (see Pars. 0009 and 0021-26, 0030, 0032 and 0037-40).

Regarding claim 15, Martinez further discloses the device of claim 11, wherein the user interface is adapted to store the switch condition in association with one of the notification profiles to facilitate re-use of the switch condition (see Pars. 0005, 0008, and 0021-26, 0030, 0032 and 0037-40).

Regarding claim 16, Martinez further discloses the device of claim 15, wherein the notification profile enablement component is adapted to access the stored switch condition for re-use (see Pars. 0005, 0008, and 0021-26, 0030, 0032 and 0037-40).

Regarding claim 17, Martinez further discloses the device of claim 10, wherein the notification profile enablement component comprises a further switch condition that, if satisfied, automatically switches from the next notification profile to a new next notification profile (see Pars. 0009 and 0021-26, 0030, 0032 and 0037-40).

Regarding claim 18, Martinez further discloses the device of claim 10, wherein the next notification profile is defined in accordance with a last notification profile enabled immediately prior to the current notification profile such that said notification profile switch component switches back to the last notification profile. (see Pars. 0009 and 0021-26, 0030, 0032 and 0037-40).

Regarding claim 19, Martinez further discloses the device of claim 10, wherein the notification profile enablement component can be programmed to temporarily activate one of the plurality of notification profiles for an amount of time determined at the mobile device (see Pars. 0009 and 0021-26, 0030, 0032 and 0037-40).

CONCLUSION

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwasi Karikari whose telephone number is 571-272-8566. The examiner can normally be reached on M-T (9am - 7pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on 571-272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8566. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Patent Examiner: Art Unit 2617.

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